

Please return this card, indicating receipt date and Serial No., if applicable, of the following

Petition Under 37 CFR 1.181(a)(3) and Renewed  
Petition Under 37 CFR 1.144

Applicant(s): Daniel A. Gately

Title: Silylated and N-Silylated Compound Synthesis

Serial No.: 09/016,641

Filing Date: 1/30/98



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:
DANIEL A. GATELY	: Art Unit 1621
Serial No. 09/016,641	:
Filed January 30, 1998	:
FOR: SILYLATED AND N-SILYLATED	: Examiner: J. Vollano
COMPOUND SYNTHESIS	:

PETITION UNDER 37 C.F.R. §1.181(a)(3)  
AND  
RENEWED PETITION UNDER 37 C.F.R. §1.144

Honorable Commissioner of  
Patents and Trademarks  
Washington, D. C. 20231

Sir:

1. The Petition Under §1.181(a)(3)

"Appropriate circumstances" for the exercise of supervisory authority exist because John Kittle, Director, Technology Center 1600/2900, has by evasion and in other ways repeatedly refused and continues to refuse to discharge his duty to rule on the merits of a key question regarding restriction practice properly, squarely and repeatedly presented on Rule 144 Petition and to forward the issue to higher authority for decision.

This surprising conduct of the Director is most recently shown by the June 2, 2000 Petition Decision which denies "applicant's second renewed petition under 37 C.F.R. 1.144, filed March 10, 2000, requesting reconsideration of the petition decisions...mailed September 21, 1999 [signed by Director

Kittle], and January 10, 2000 [also signed by Director Kittle]" (p. 1).

In addition, it appears that the Director acted improperly in purporting to deny the March 10, 2000 renewed petition. His duty instead was to grant that March 10, 2000 petition or to send it forth to higher authority for disposition—just as the examiner understood would be done and advised applicant's counsel would be done. Consequently, the June 2, 2000 Petition Decision is deemed void.

Of great concern, not merely to applicant but to the public, is the apparent election of the director and examiners in Technology Center 1600/2900 to avoid or preclude any definitive ruling on the validity of any requirement for "restriction within a claim" purportedly pursuant to 35 U.S.C. §121.

#### The "Restriction-Within-a-Claim" Practice

The "restriction-within-a-claim" practice involves the examiner's breaking of a claim or claims into "parts" and then requiring restriction—not between the claims as presented—but

instead between examiner's selected claim "parts".<sup>1</sup> It is this practice which is challenged by all of the petition proceedings in this application, each of which disputes the January 7, 1999 restriction requirement which states, in part:

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3 (in part) and 4, drawn to silyl compound, classified in class 556, subclass 426.
  - II. Claims 1-3 (in part), 5-6 and 14-15, drawn substituted amines, classified in class 556 and 564, subclasses various.
  - III. Claim 7 (in part), drawn to method of use of silylated compounds, classified in class 556, subclass 426.
  - IV. Claims 7 (in part) and 8, drawn to a method of use of substituted amines, classified in class 564, 556, subclass various. (p. 2)

Prior Proceedings

The June 2, 2000 Petition Decision denies "applicant's second renewed petition under 37 CFR 1.144, filed March 10,

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<sup>1</sup> The June 2, 2000 Petition Decision "mischaracterizes the restriction within a claim" practice and, therefore, covers up the true issue involved. That Petition Decision incorrectly states "restrict within a claim, or in other words to have the same claim assigned to multiple groups of invention" (p. 1; second paragraph). The issue is the way in which the "same claim [is] assigned to multiple groups of invention".

2000". The Decision ignores the timely filed "Supplement" to the petition it purports to deny.

At an interview on April 24, 2000, applicant's counsel was more fully informed by the examiner regarding the challenged "restriction within a claim" practice. On May 1, 2000, counsel therefore filed and faxed to Art Unit 1621 at 2:23 p.m. a "Supplement to 'Renewed Petition under 37 C.F.R. §1.144' filed March 10, 2000". The Fax Cover Sheet also states: "Please bring this fax and its attachments to the prompt attention of Examiner Vollano, Art Unit 1621. Thank you." The fax confirmation reports "OK" transmission of 13 pages.

As noted, the June 2, 2000 Petition Decision does not acknowledge the Supplement to the Petition it purports to deny—although that Supplement was received one month before the Petition Decision is dated.

To avoid any further disregard of it, a copy of the Supplement is attached hereto. The person who rules on this petition will find pages 2, 3, 4 and 5 (first three lines) of the Supplement to be instructive. Consideration of these pages is deemed essential to the informed ruling to which applicant is entitled.

**Evasion of Ruling on the Validity of  
the "Restriction Within a Claim" Practice**

The desire of the examiner to avoid establishing any "precedent which might preclude restriction within a claim" is explained in the Supplement's "Fact Statement" at pages 4-5. Specifically, the examiner suggested withdrawal of the within-a-claim restriction requirement in exchange for applicant's withdrawal of the Renewed Petition which the director "DENIED" on June 2, 2000. See the April 17, 2000 Interview Summary which states:

The examiner has agreed to rejoin all non nitrogen claims both process + compounds if applicant cancels all nitrogen directed claims. Applicant proposes withdrawing petition for speedy prosecution. The amendment if presented must be filed timely.

See also the April 24, 2000 Interview Summary, last two sentences: "Applicant does not want to withdraw the petition and it will be sent forth" (emphasis added). However, the petition was not "sent forth". Instead, the director interceded, usurped prerogative he apparently does not have, and "DENIED" the Renewed Petition on June 2, 2000.

The need for "supervisory authority" is obvious.

The June 2, 2000 Petition Decision

To evade "sen[ding] forth" the petition—and forestall an authoritative disposition of the "restriction within a claim" issue—the June 2, 2000 Petition Decision states:

Applicant reiterates the position that it is improper to restrict within a claim, or in other words to have the same claim assigned to multiple groups of invention. Applicant's position is noted, however since this applies only to Groups I, II and IV, none of which were elected, the issue is considered moot. Applicant's election of Group V, in which none of the claims are assigned to any other Group, with traverse was proper....

The director's dismissal of the restriction-within-a-claim issue as moot is sophistry. Applicant's election of Group V was a provisional election under 37 C.F.R. §1.143 and paragraph 8 of the restriction requirement (Request for Reconsideration filed January 14, 1999, p. 1), and automatically withdrawn (p. 5) if the traverse were sustained. The traverse, however, was on the ground that the required "restriction within a claim" was invalid. See "Reasons for Request", pp. 2, et seq. of the January 14, 1999 "Request for Reconsideration".

Therefore, the June 2, 2000 Petition Decision sub silentio rules affirmatively upon and finds "proper" the propriety of the very "restriction-within-a-claim issue" which it attempts to moot. An informed and definitive disposition of that issue by

the Commissioner in the exercise of supervisory authority is long overdue.

2. The Petition Under 37 C.F.R. §1.144

The §1.144 petition requests, again, a clear and definitive ruling on the propriety of the restriction-within-a-claim practice.

Relief Requested

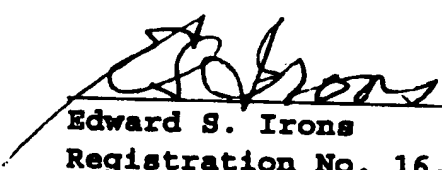
The Commissioner is requested to enter an order which:

- (1) vacates the Petition Decision filed June 2, 2000;
- (2) directs the director to forward this application to "higher authority";
- (3) directs such "higher authority" to issue a definitive ruling upon the propriety or impropriety of the restriction-within-a-claim practice; and
- (4) if the restriction-within-a-claim practice is deemed improper, to vacate the original restriction requirement of January 7, 1999 in this application.



AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Any fee due may be charged to Deposit Account 09-0948.



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